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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,284	06/12/2000	FRANCOIS SMOLAREK	106498	5209

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 11/21/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/592,284

Applicant(s)

SMOLAREK, FRANCOIS

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on September 5, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) 87-97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 5, 2002 has been entered.

2. Newly submitted claims 87-97 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 87-97 are directed to a method for manufacturing a stick of a cosmetic product, whereas the originally presented claims were directed to an mold for manufacturing a stick. These two inventions are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP § 806.05(e). In this case, the apparatus as claimed could be used to practice another and materially different process such as a process wherein mechanical force is used to expand the mold

and remove the product, rather than suction as required by the method claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 87-97 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP §§ 818.02(a), 821.03.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification needs to set forth that the zones of weakness extend longitudinally beyond a bottom of the inner cavity of the mold as is recited in new claim 75. It is noted that this does not constitute new matter as this feature is clearly set forth in figure 1 of the originally filed drawings. See In re Wolfensperger, 302 F.2d 950, 133 USPQ 537 (Cust. & Pat. App. 1962).

4. Claims 5 and 75 are objected to because of the following informalities:

Claim 5 has two periods at the end of it.

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Claim 75 recites "a side wall which includes zone of weakness...at least one of said zones of weakness..." The first recitation of "zone" in this claim should be plural --zones--.

Appropriate correction is required.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-10, 55-65, 68-69, and 74 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed application did not set forth that the inner surface of the mold is "seamless". Therefore this limitation constitutes new matter. Note, the mere absence of a positive recitation is not the basis for a negative limitation such as "seamless". See MPEP § 2173.05(i).

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7. The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6-7, 16-17, 27-28, 38-39, 49-50, 60-61, and 80-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "close" in the phrase "close to a bottom end of the mold" in claims 6, 16, 27, 38, 49, 60, and 80 is a relative term which renders the claim indefinite. The term "close" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In this case therefore, it would not be possible to determine what constituted "close" to the bottom end of the mold. Note, claims 7, 17, 28, 39, 50, 61, and 81 depend from claims 6, 16, 27, 38, 49, 60, and 80 and are therefore indefinite as well.

Claim 80 is further indefinite in that it is recited to depend on itself. It is believed, based on the other pending

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claims, that this claim was meant to depend from claim 78.

Therefore this claim will be evaluated on its merits against the prior art as if it depended on claim 78. However, appropriate correction and/or clarification is required.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5, 9, 33-37, 42-48, 53-54, 69, 72-73, 75-79, and 84-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Henning (US Pat. No. 3,934,810).

Henning teaches, with reference to the embodiment shown in figures 7-8, a mold wherein the mold has a seamless inner surface (defining cavity 81) and a side wall which includes zones of weakness facilitating radial deformation thereof (see col. 1, lns. 59-66).

Henning further teaches the zones of weakness to be notches (87) made in the side wall of the mold, uniformly distributed in a periphery of the mold (see fig. 8). Henning also teaches the notches to extend over substantially an entire height of the

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mold all the way to the bottom of the mold (fig. 7), and the bottom of the notches to be rounded (93). As shown in scale of figure 8, Henning further teaches that the thickness of the side wall between the notches and the cavity is greater than 1 mm, and that the notches have a depth greater than 4 mm.

Henning further teaches the mold to have a flange portion (77) at the top portion of the mold surrounding the opening in the mold (see fig. 7). Henning also teaches the notches to extend beyond the bottom of an inner cavity (81) of the mold (see fig. 7).

Claims 69, 72-73, and 86 recite that the mold is configured to be filled with a cosmetic product. The actual intended use of the apparatus, whether it be to make a cosmetic product or anything else, is not germane to the issue of patentability of the apparatus claims. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963); see also MPEP §2115. In the instant case, Henning teaches the mold to be used with "a hardenable mixture" (col. 1, ln. 6), and to comprise a completely closed cavity (81) for containing the mixture (see fig. 7). Therefore, the apparatus of Henning is capable of being



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used with a hardenable mixture such as that which would form a cosmetic product, and therefore anticipates the limitations of claims 69, 72-73, and 86.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 6-8, 10, 38-41, 49-52, and 82-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning.

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Henning teaches the mold as described above. Henning fails to teach the mold to have sixteen to twenty notches, or more specifically, eighteen notches. However, Henning does teach that the number of notches is not critical, and that more or less can be added (see col. 4, lns. 30-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the mold of Henning as such to have provided eighteen notches because number of notches is not critical and could be adapted to meet a particular use of the apparatus as suggested by Henning.

Henning further teaches in the embodiment shown in figures 5-6, the notch to formed in the side of the mold such that the depth of the notch decreases towards the bottom of the mold as an alternative to the embodiment shown in figures 7-8 and described above. Note that the depth of the notch decreases as it come "close" to the bottom end of the mold (see the rejection under 35 U.S.C. 112, second paragraph above concerning the scope of the word "close"). In both cases, Henning notes that the alternative notches allow for the radial deformation of the mold (see col. 1, lns. 59-66, col. 3, lns. 5-30, and col. 3, ln. 60 - col. 4, ln. 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention that notches which decrease in depth towards the

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bottom end of the mold could have been substituted for the notches which are the same depth to the bottom of the mold because the decreasing depth notches are taught as alternatives by Henning which achieve the purpose of allowing the mold to radially deform.

14. Claims 11-32, 55-68, 70-71, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning as applied to claims 1-10, 33-54, 69, 72-73, 75-79, and 82-86 above, and further in view of Fox et al. (US Pat. No. 3,937,438; previously of record).

Henning teaches the apparatus as described above. Henning fails to teach the mold cavity-opening to have a sloping bottom wall, or a cavity having a part formed by two successive conical surfaces converging towards an opening in the mold, or the cavity to be partially defined by a conical surface.

The mold cavity-opening shape determines the shape of the product to be manufactured. Henning teaches different cavity shapes which would form products of different shapes (compare cavity 25 in the embodiment shown in figures 2-4, with cavity 81 shown in figures 7-8). In the same field of endeavor, Fox teaches another example of a different cavity shape (21) to produce different shaped products (45). Therefore, it is known

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in the art that the shape of the cavity may be manipulated in order to produce products of different shapes.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the mold cavity of Henning as such to have a slopping bottom wall, two successive converging conical surfaces, or be partially defined by a conical surface because these cavity shapes would have allowed for the molding of correspondingly shaped products as is suggested by Henning and Fox.

15. Applicant's arguments with respect to claims 1-86 have been considered but are moot in view of the new ground(s) of rejection.

16. Claims 80-81 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a mold for manufacturing a stick, wherein the mold has a side wall

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which includes zones of weakness facilitating radial deformation of the mold, at least one of the zones extending longitudinally beyond a bottom of the inner cavity of the mold, wherein the zones of weakness are notches, and wherein the depth of the notches decreases along the length of the notches towards the bottom of the mold.

The closest prior art taught by Henning is described above. Henning does teach an embodiment wherein the depth of the notch decreases towards the bottom of the mold (see fig. 5). Henning in a different embodiment, teaches the notch to extend longitudinally beyond a bottom of the inner cavity of the mold (fig. 7). However, Henning does not teach a notch that extends longitudinally beyond a bottom of the cavity, and has a depth that decreases towards the bottom of the mold, nor is there a suggestion in the Henning reference to combine the notch features to produce such a notch. Nor does any of the prior art of record teach or suggest the notch to be constructed as such.

18. Although not currently claimed, the Examiner suggests Applicant amend the application to recite a mold as would be described in the combination of subject matter recited claims 1, 3, and 6. A mold comprising zones of weakness in the side walls, with the zones of weakness being notches extending over

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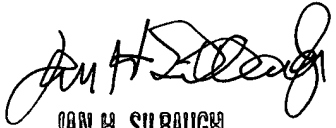
substantially an entire height of the mold all the way to a bottom end of the mold, and wherein the depth of the notches is decreased towards the bottom end of the mold is not taught or suggested by the prior art, and therefore would be allowable over the prior art of record.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jan Silbaugh, can be reached at (703) 308-3829. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Donald Heckenberg  
November 14, 2002

  
JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
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11/18/02